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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,038	10/15/2001	Timothy W. Dygert	2167.017US1	2537

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EXAMINER

BROMELL, ALEXANDRIA Y

ART UNIT	PAPER NUMBER
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2167

MAIL DATE	DELIVERY MODE
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01/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/976,038

Applicant(s)

DYGERT ET AL.

Examiner

Alexandria Y. Bromell

Art Unit

2169

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/28/07, 10/09/07, 10/22/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office Action is in response to Applicant's Request for Continued Examination (RCE), filed 9/28/07. Claims 1-5, which are currently pending, are considered below.

Information Disclosure Statement

The information disclosure statements (IDS) submitted on 9/28/07, 10/09/07, and 10/22/07 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims fail to place the invention squarely within one statutory class of invention. In [0044] and [0063] of the instant specification, applicant has provided evidence that applicant intends the "medium" to include signals. As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim(s) is/are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefor not a composition of matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al. (European Patent Application EP1107254A2) in view of Janik (U.S. Patent 7142934).

With respect to claim 1, Kaneko teaches a recorded signal output device to reproduce a recorded signal from a recording (i.e. a recorded signal is reproduced from a home PC by a recording and reproducing apparatus in a car using electric communication, [0049]), a video output to provide the textual data to the display unit (i.e. display unit shows information like the title of each unit that is reproduced, [0018]), a memory to store a textual recording name of the recording and indicating data obtained from said recorded signal output device, that can be used for identification of the recording (i.e. memory stores audio information, unit information, and music lists,

[0011]), a communication device, occasionally in communication with the remote database, to obtain the textual recording name by sending the indicating data to the remote database (i.e. reproducing apparatus in communication with home PC, which sends textual information about audio selection, [0061]), A controller, coupled to said recorded signal output device, said video output, said memory and said communication device, to control said apparatus to play back the recording regardless of whether said communication device is in communication with the remote database (i.e. reproducing apparatus plays back a recording regardless of whether communication device is in communication with remote database because it is reading from a DVD-ROM, so it is playing back independently, [0052]), to query the remote database using the indicating data when communication is established and to supply the textual recording name of the recording from the remote database to said memory (i.e. reproducing system queries home system for textual information about the unit being reproduced, [0031]). Kaneko does not explicitly disclose that the system is repeatedly trying to establish communication with the remote database. However, Janik teaches that the system repeatedly try to establish communication with the remote database (i.e. system depends on streaming data from personal computer, column 5, lines 48-50). Kaneko and Janik are analogous art because they are from the problem solving area of allowing a user to listen to and manage a reproduced audio piece from a remote location. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Kaneko and Janik before him or her, to modify the system of Kaneko with the teachings of Janik in order to use Wireless LAN technology specifics to

communicate remotely between a home PC and an audio playback device (Kaneko, column 5, lines 7-26). The motivation for doing so would have been to send and receive audio data in a local area network so that it can be played back in an audio playback device (Janik, column 3, lines 20-28). Therefore, it would have been obvious to combine Janik with Kaneko to obtain the invention as specified in the instant claim(s).

With respect to claim 2, Kaneko teaches wherein the communication device is a cellular two-way network interface (i.e. communication device is a portable cellular phone, [0028]).

With respect to claim 3, Kaneko teaches that the communication recording device is located inside a car [0025-0026]. Kaneko does not explicitly disclose that the communication device is an 802.11a network interface. However, Janik teaches wherein the communication device is an 802.11a network interface (i.e. the communication device may use an 802.11a network interface, (column 2, lines 18-20)). Therefore, the limitations of claim 3 are rejected in the analysis of claim 1 above, and the claim is rejected on that basis.

With respect to claim 4, Kaneko teaches that the communication recording device is located inside a car [0025-0026]. Kaneko does not explicitly disclose that the communication device is an 802.11b network interface. However, Janik teaches wherein the communication device is an 802.11b network interface (i.e. the communication device may use an 802.11a network interface, (column 5, lines 7-26)). Therefore, the limitations of claim 4 are rejected in the analysis of claim 1 above, and the claim is rejected on that basis.

With respect to claim 5, Kaneko teaches an audio reproducing apparatus in a car [0010]. Kaneko does not explicitly disclose that the communication device is a Bluetooth network interface. However, Janik teaches that the portable communication device uses similar Bluetooth technology between a PDA and a wireless LAN adapter (column 13, lines 46-56, and column 6, lines 23-37). Therefore, the limitations of claim 5 are rejected in the analysis of claim 1 above, and the claim is rejected on that basis.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexandria Y. Bromell whose telephone number is 571-270-3034. The examiner can normally be reached on M-R 6:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ali can be reached on 571-272-4105. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
09/976,038
Art Unit: 2169

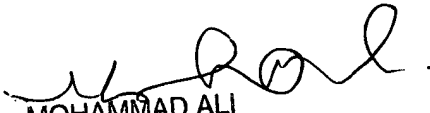
Page 7

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alexandria Y Bromell
Examiner
Art Unit 2169

AYB

January 5, 2008


MOHAMMAD ALI
SUPERVISORY PATENT EXAMINER